

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Dennis E. Smith, et al

IMPROVED VOIDED ARTICLES

Serial No. 10/033,457

Filed 27 December 2001

Group Art Unit: 1772

Examiner: Walter Aughenbaugh

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. 41.52

In response to the Decision on Appeal mailed 03/10/2009, Appellants request rehearing based on the following points believed to have been misapprehended or overlooked by the Board.

Regarding the rejection of claims 1, 2, 5, 7, 9-17, 21, 22, 24-26, 28-36 and 39 as being anticipated by Maier et al., the Board states at page 15 of the Decision that as a 90/10 methylmethacrylate/divinylbenzene composition exhibits a Δb^* of 0.150, that accordingly “it is reasonable to expect that Maier’s composition of 95/5 methylmethacrylate/divinylbenzene would inherently have a similar Δb^* value within the claimed range”, i.e., of less than or equal to 0.2. Appellants do not contest that the 95/5 methylmethacrylate/divinylbenzene composition would have a Δb^* value of less than 0.2, as such can clearly be inferred from the reported Δb^* values for the 70/30 and 90/10 compositions. The Board misapprehends Appellant’s actual argument at page 13 of the Brief, which is not that the 95/5 methylmethacrylate/divinylbenzene composition itself would not have such a low Δb^* value (such composition is not even mentioned in such specific argument),

but rather that based on the fact that the Δb^* value may or may not be less than 0.2 for various compositions that fall within the broad description of suitable materials described in Maier (as evidenced by the reported Δb^* values in Table AF-1), Maier does not in general inherently (i.e., necessarily) teach or require that all the microbeads thereof have such a Δb^* value. Similarly, the data of Table AF-2 is relied upon to demonstrate that various compositions that fall within the broad description of suitable materials described in Maier may or may not have a 2% weight loss temperature of above 270 C, and that Maier accordingly does not in general inherently (necessarily) teach or require that all the microbeads thereof have such thermal stability.

While the Board apparently approves of inferring the Δb^* value for the 95/5 methylmethacrylate/divinylbenzene composition of Maier as being less than 0.2 based on the reported values for the 70/30 and 90/10 compositions, it then finds at pages 15-16 of the Decision that Appellant's arguments that the thermal stability of the 95/5 composition would be less than that of the 90/10 composition (i.e., less than 260 °C) based on the actual measured data for the 70/30 and 90/10 compositions (i.e., 300 C and 260 °C, respectively, as reported in the Smith Declaration) to not be persuasive. The Board apparently misapprehends or overlooks that such positions it has taken with respect to appropriateness of inferring the Δb^* and thermal stability values for the 95/5 compositions are clearly inconsistent. Appellants have simply similarly argued that the thermal stability for the 95/5 composition of Maier would be less than that measured for the 90/10 composition, and thus less than that claimed, based on the established trend of thermal stability decreasing with lower crosslinking percentages (as demonstrated for the 70/30 and 90/10 methylmethacrylate/divinylbenzene compositions in the Smith Declaration, as well as for other compositions as shown in Table 6 at pages 23-24 of the specification).

While the Board states at page 15 of the Decision that Appellants have the burden of showing that Maier's 95/5 PMMA/divinylbenzene composition does not possess the non-yellowing characteristic, the more appropriate statement would appear to be that Appellant has the burden of showing that such 95/5 composition does not possess the combined claimed requirements of both Δb^* value and

thermal stability requirement. As Appellant has provided sufficient evidence to parallelly show that it is reasonable to expect Maier's 95/5 composition to have a thermal stability of less than that measured for the 90/10 composition, similarly as the Board relies on the reported Δb^* data to find that the light stability of the 95/5 composition would be within the claimed requirement, it is respectfully urged that Appellants have met such burden. Reconsideration and reversal of the anticipation rejection on rehearing is accordingly respectfully requested.

Further regarding the rejection of Claims 18, 19, 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over Maier et al. (i.e., "rejection 3"), the Board states at page 3 of the Decision that they render their decision 'by focusing on the same arguments directed to the same claim 1 features'. The Board further states at page 13 of the Decision that "Appellants do not contest the Examiner's obviousness conclusions in light of the applied prior art with regard to the claim features the Examiner determined to be absent from Maier", but rather "focus on the inherency of the thermal stability and non-yellowing properties, which the Examiner found to be inherently possessed by Maier." The Board misapprehends or overlooks, however, that rejection 3 is directed towards claims which specifically include the added requirement that the second polymer is derived from monomers comprising more than 20 Wt% of crosslinking monomer. As both the Examiner and Appellant have noted that Maier fail to explicitly teach such requirement (Brief, page 15), and as Appellant has argued that the prior art reference must teach or suggest all the claim limitations to establish a prima facie case of obviousness (Brief, page 17), Appellants urge that it was improper for the Board to not select one of the actually rejected claims as the representative claim for rejection 3. In doing so, it is clear, even in the absence of actual measured data for the 95/5 composition of Maier, Maier does not teach or suggest any specific composition that meets all of the claim requirements of less than 10 wt% styrenic monomers, more than 20wt% of crosslinking monomers, 2% weight loss above 270 °C, and Δb^* less than or equal to 0.2. Reconsideration of the rejection of claims 18, 19, 37 and 38 as obvious over Maier et al. on rehearing is accordingly respectfully requested

The Board further states at page 17 of the Decision that “Appellants do not dispute that the Examiner’s combination of the various secondary references with Maier to meet the various features of the claims rejected under § 103 would have been obvious. The Board misapprehends or overlooks that Appellant has argued that the secondary references are directed towards different fields (e.g., “Saito also fails to disclose microbeads...”; “Saito fails to mention microbeads bordered by void space.”; “Saito also fails to mention the problems of thermal stability and yellowness as presently defined...”; “Maier and Saito fail to provide any likelihood of success...”; etc.), and thus fail to suggest the modification necessary to achieve the present claims (see, e.g., Brief, pages 24-25). Regarding Appellant’s arguments as to unexpected results, the Board relies upon Maier’s disclosure that the shaped articles “have superior thermal and chemical stability, and are virtually free of yellowing over time (Decision page 17, referencing FF 15-16), and finds that Smith Declaration does not establish unexpected results. The Board misapprehends or overlooks, however, that such disclosure in Maier are with respect to alleged properties (no actual data is provided) of the shaped article itself (e.g., synthetic paper) relative to cellulose ester compositions and cellulose-based papers, not to any teaching as to selection of microbead compositions themselves which will demonstrate the presently claimed performance requirements. As the present application specification establishes that one of the actually employed microbead formulations of Maier exhibits excessive yellowing (70/30 methylmethacrylate/divinylbenzene as indicated in Table 1), and the Smith Declaration establishes that the other actually employed microbead formulation of Maier would exhibit low thermal stability (95/5 methylmethacrylate/divinylbenzene, based on the measured thermal stability performance of 70/30 and 90/10 methylmethacrylate/divinylbenzene compositions), reconsideration of this position with respect to the further rejections on rehearing is respectfully requested.

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reconsider the Decision on Appeal mailed March 10, 2009.

Respectfully submitted,



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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.